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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/810,286	03/16/2001	Jacques Fieschi	FR920000012US1	5924
7590 09/12/2005			EXAMINER	
ANDREW CALDER MCGUIRE WOOD LLP 1750 TYSONS BLVD SUITE 1800 MCLEAN, VA 22102			WORJLOH, JALATEE	
			ART UNIT	PAPER NUMBER
			3621	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/810,286

Applicant(s)

FIESCHI ET AL.

Examiner

Jalatee Worjloh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 August 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn.
2. Claims 1-25 have been examined.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 8 is rejected as being a single means claim.

A single means claim, i.e., where a means recitation does not appear in combination with another recited element of means, is subject to an undue breadth rejection under 35 U.S.C. 112, first paragraph. In re Hyatt, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983) (A single means claim which covered every conceivable means for achieving the stated purpose was held nonenabling for the scope of the claim because the specification disclosed at most only those means known to the inventor.). When claims depend on a recited property, a fact situation comparable to Hyatt is possible, where the claim covers every conceivable structure (means) for achieving the stated property (result) while the specification discloses at most only those known to the inventor.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-3, and 9 are rejected under 35 U.S.C. 102(e) as being anticipated by US Patent No. 6098053 to Slater.

Referring to claim 1, Slater discloses registering a purchase of at least one article by a buyer using a credit/debit card associated with at least one PIN code (security information including a secret number such as a personal identification number) at a seller terminal connected to an electronic payment center by a communication network (see col. 7, lines 26-40, 60-63 – a purchaser places an order at a merchant's web site and enters his card number and PIN), checking, by the electronic payment center (i.e. "financial institution"), that the at least one PIN code which is provided by said buyer to said electronic payment center is associated with the number of said credit/debit card provided by said buyer to said seller terminal (see col. 9, lines 13-15, 65-67; col. 10, line 1 – financial institution validates financial transaction instruction), and checking, by said electronic payment center, with a third party (i.e. "purchaser's bank")

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whether or not said at least one PIN code is valid (see col. 10, lines 10-15,32-34). Also see Fig. 1.

Referring to claim 2, Slater discloses the method wherein said buyer has a terminal (i.e. personal computer) which is connected to the communication network and said terminal is configured to transmit the number of the credit/debit card (see fig. 1,(12,13), col. 5, lines 44-55 and col. 7, lines 44-49).

Referring to claim 3, Slater discloses the method wherein the credit/debit card number and the at least one PIN code which have been provided to said seller terminal by said buyer are transmitted to said electronic payment center to check whether the at least one Pin code is associated with said credit/debit card number (see claim 1 above).

Referring to claim 9, Slater discloses receiving transaction information from a buyer and a seller by an electronic payment center, performing a first validation with the transaction information from the buyer and seller by the electronic payment center, requesting, by the electronic payment center, further validation from a third party to provide authentication by an electronic transaction (see claim 1 above), and processing the sale by an electronic transaction upon authentication by the first validation and the further validation (see col. 10, lines 40-50).

Referring to claim 10, Slater discloses the transaction information sent by the buyer is at least one article information, date and time of purchase, buyer PIN code, and credit/debit card number and the transaction information sent by the seller is at least one article information date and time of purchase, and PIN code (see col. 7, lines 7-25).

Referring to claim 11, Slater discloses the method wherein article information includes purchase price (see col. 7, lines 19-22).

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Referring to claim 12, Slater discloses the seller receiving a credit/debit card number, an article identification, a transaction time a transaction date, and a buyer PIN code from the buyer (see col. 7, lines 7-25).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 4, 13-15 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater as applied to claims 3 and 9 above, and further in view of US Patent No. 5999624 to Hopkins.

Referring to claim 4, Slater discloses an electronic payment center (see claim 1 above). Slater does not expressly disclose the method wherein said electronic payment center checks in at least one profile table whether said PIN code is associated with the credit/debit card number. Hopkins discloses wherein said electronic payment center checks in at least one profile table whether said PIN code is associated with the credit/debit card number (see col. 9, lines 58-62). At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose by Slater to include the step wherein said electronic payment center checks in at least one profile table whether said PIN code is associated with the

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credit/debit card number. One of ordinary skill in the art would have been motivated to do this because it verifies the user's identity, thereby minimizing fraud.

Referring to claims 13 and 14, Slater discloses an electronic payment center (see claim 9 above). Slater does not expressly disclose the electronic payment comparing at least one portion of the transaction information with profile table information, wherein the profile information comprises at least one of a credit/debit card number, a buyer PIN code, and an authorization amount corresponding to the buyer PIN code. Hopkins discloses the electronic payment comparing at least one portion of the transaction information with profile table information, wherein the profile information comprises at least one of a credit/debit card number, a buyer PIN code, and an authorization amount corresponding to the buyer PIN code (see col. 9, lines 58-62). At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose by Slater to include the electronic payment comparing at least one portion of the transaction information with profile table information, wherein the profile information comprises at least one of a credit/debit card number, a buyer PIN code, and an authorization amount corresponding to the buyer PIN code. One of ordinary skill in the art would have been motivated to do this do this because it verifies the user's identity, thereby minimizing fraud.

Referring to claim 15, Slater discloses the electronic payment center clears the at least one portion of transaction information from the third party (see col. 10, lines 46-59).

Referring to claim 20, Slater discloses an electronic payment center and a buyer (see claim 9 above). Slater does not expressly disclose sending an error message to the buyer if the purchase amount is outside an authorized limit of the credit/debit card. Hopkins discloses

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sending an error message to the buyer if the payment amount is outside an authorized limit of the credit/debit card (see col. 9, lines 58-67; col. 10, lines 1-4). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to modify the method disclosed by Slater to include the step of sending an error message to the buyer if the amount is outside an authorized limit. One of ordinary skill in the art would have been motivated to do this because it provides excellent customer service by notifying the consumer.

8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slater and Hopkins as applied to claim 4 above, and further in view of U.S. Patent No. 5,953,710 to Fleming.

Slater discloses an electronic payment center (see claim 4 above). Slater does not expressly disclose the step of checking by said payment center whether the amount of purchase of the at least one article is below a maximum amount authorized for the at least one PIN code, each PIN code authorizing a different maximum amount. Fleming discloses the step of checking by said payment center (see col. 7, lines 38-42 – when a parent or child desires to make a purchase, the request is processed by the Bank Approval Processing System) whether the amount of purchase of the at least one article is below a maximum amount authorized for the at least one PIN code (see col. 8, lines 21-54 – the Bank compares the available credit for the account with the expenditure amount) each PIN code authorizing a different maximum amount (see col. 6, lines 20-45 – the database stores a parent account record and a child account record including a PIN Code Field and the Credit Limit Field, particularly, “the PIN code Field in the parent’s account record is used to verify the PIN input”... “a child’s account optionally may have a PIN Code Field.... “The child’s available credit is maintained separately from the parent’s available credit. The child’s available credit is initially set to zero, but may be changed to a value

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specified by the parent at the time the child's account is created."; thus, each PIN code, which is associated with a different account (i.e. parent or child) have a different available credit/maximum amount. At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose by Slater to include the step of checking by said payment center whether the amount of purchase of the at least one article is below a maximum amount authorized for the at least one PIN code, each PIN code authorizing a different maximum amount. One of ordinary skill in the art would have been motivated to do this do this because it ensures that the merchant is paid for the service provided.

9. Claims 6, 7 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater Hopkins and Fleming as applied to claim5 above, and further in view of US Patent No. 6205437 to Gifford.

Referring to claims 6 and 7, Slater discloses an electronic payment center and a buyer (see claim 5 above). Slater does not expressly disclose checking by said electronic payment center whether or not there is a prevalidation of the purchase of the at least one article by said buyer. Gifford discloses checking by said electronic payment center whether or not there is a prevalidation of the purchase of the at least one article by said buyer (see col. 7, lines 40-61), wherein said prevalidation of the purchase of the at least one article by said buyer is cleared after it has been used (see col. 8, lines 51-65). At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose Slater to include checking by said electronic payment center whether or not there is a prevalidation of the purchase of the at least one article by said buyer. One of ordinary skill in the art would have

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been motivated to do this do this because it eliminates duplicate charges to the consumer account.

Referring to claim 21, Slater discloses an electronic payment center (see claim 6 above). Slater does not expressly disclose prevalidation of the purchase ordered by said buyer, bypassing the step of checking, by said electronic payment center, with a third party whether the at least one PIN code is valid. Gifford disclose prevalidation of the purchase (see claim 6 above). As for prevalidation of the purchase ordered by said buyer, bypassing the step of checking, by said electronic payment center, with a third party whether the at least one PIN code is valid, this is an inherent step. PIN odes are usually utilized to authorize a user's identity; thus, if the identity has been previously verified there is no need to further validate the user.

10. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slater in view of Gifford.

Slater discloses receiving transaction information from a buyer and a seller by an electronic payment center, performing a validation with the transaction information from the buyer and seller by the electronic payment center, providing authorization for a sale when the validation provide authorization (see claim 9 above). Slater does not expressly disclose performing a pre-validation of buyer information with a third party and providing authentication for a sale by an electronic transaction when the prevalidation provide authorization. Gifford discloses performing a pre-validation of buyer information with a third party and providing authentication for a sale by an electronic transaction when the prevalidation provide authorization (see col. 7, lines 40-61). Combining the methods of Salter and Gifford teach the

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step of providing authentication for a sale by an electronic transaction when the prevalidation and validation provide authorization. At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method of Slater to include performing a pre-validation of buyer information with a third party and providing authentication for a sale by an electronic transaction when the prevalidation provide authorization. One of ordinary skill in the art would have been motivated to do this do this because it provides additional security, thereby reducing fraud.

11. Claims 17-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater and Gifford as applied to claim 16 above, and further in view of Hopkins.

Referring to claim 17, Slater discloses an electronic payment center (see claim 16 above). Slater does not expressly disclose determining, by the electronic center, whether an amount charged to a credit card number is within an authorized limit, if a PIN code of the transaction information is verified. Hopkins discloses determining, by the electronic center, whether an amount charged to a credit card number is within an authorized limit, if a PIN code of the transaction information is verified (see col. 9, lines 58-67). At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose by Slater to include the step of determining, by the electronic center, whether an amount charged to a credit card number is within an authorized limit, if a PIN code of the transaction information is verified. One of ordinary skill in the art would have been motivated to do this because it ensures that the merchant receives compensation for the service provided.

Referring to claim 18, Slater discloses an electronic payment center (see claim 17 above). Slater does not expressly disclose checking for prevalidation of the PIN code when the amount

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charged to the credit card number is within an authorized amount (see col. 7, lines 40-61). At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose by Slater to include the step of checking for prevalidation of the PIN code when the amount charged to the credit card number is within an authorized amount. One of ordinary skill in the art would have been motivated to do this because it reduces fraud by verifying the user's identity.

Referring to claim 19, Slater discloses an electronic payment center and a buyer (see claim 18 above). Slater does not expressly disclose sending an error message to the buyer if the amount is outside an authorized limit. Hopkins discloses sending an error message to the buyer if the amount is outside an authorized limit (see col. 9, lines 58-67; col. 10, lines 1-4). At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose by Slater to include the step of sending an error message to the buyer if the amount is outside an authorized limit. One of ordinary skill in the art would have been motivated to do this because it provides excellent customer service by notifying the consumer.

12. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Slater as applied to claim 1 above, and further in view of US Patent No. 6014650 to Zampese.

Slater discloses an electronic payment method (see claim 1 above). Slater does not expressly disclose the method wherein each PIN code of the at least one PIN code is used only once a different PIN code of the at least one PIN code is use for a later transaction. Zampese discloses the method wherein each PIN code of the at least one PIN code is used only once a different PIN code of the at least one PIN code is use for a later transaction (see col. 2, lines 1-4). At the time the invention was made, it would have been obvious to a person of ordinary skill the

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art to modify the method disclose by Slater to include the method wherein each PIN code of the at least one PIN code is used only once a different PIN code of the at least one PIN code is use for a later transaction. One of ordinary skill in the art would have been motivated to do this because it provides additional security thereby reducing fraud.

13. Claims 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Slater as applied to claim 1 above, and further in view of US Patent No. 6213391 to Lewis.

Referring to claims 23 and 24, Slater discloses an electronic payment method (see claim 1 above). Slater does not expressly disclose the method wherein the at least one PIN code is associated with two or more members of a group and the group is associated with the number of the debit/credit card. Lewis discloses the method wherein the at least one PIN code is associated with two or more members of a group and the group is associated with the number of the debit/credit card, wherein the at least one PIN code is different for different members of the group and wherein the at least one PIN code authorizes a different purchasing amount for the different members of the group (see col. 5, lines 40- col. 6, line 59). At the time the invention was made, it would have been obvious to a person of ordinary skill the art to modify the method disclose by Slater to include at least one PIN code is associated with two or more members of a group and the group is associated with the number of the debit/credit card. One of ordinary skill in the art would have been motivated to do this do this because it provides additional security.

Referring to claim 25, Slater discloses a third party who limits a buyer's payment to an amount of available credit, which is synonymous to the step wherein the third party is a member of the group and the third party limits a transaction involving the credit/debit card to a pre-determined purchasing amount (see col. 10, lines 40-50).

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Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- US Patent No. 6853987 to Cook discloses a method for authorizing transactions between a customer and an e-commerce merchant.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jalatee Worjloh whose telephone number is (571) 272-6714. The examiner can normally be reached on Mondays-Thursdays 8:30 - 7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300 for Regular/After Final Actions and (571)273-6714 for Non-Official/Draft

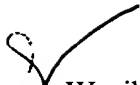
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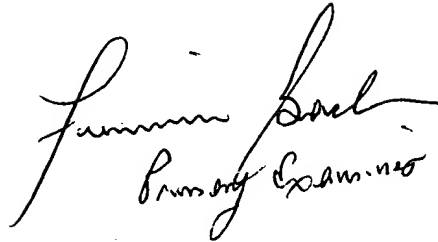
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Jalatee Worjloh
Patent Examiner
Art Unit 3621

August 29, 2005


Primary Examiner